REMARKS

This Application has been carefully reviewed in light of the Office Action mailed on March 9, 2006 ("Office Action"). Claims 1, 3, 6-11, 14-16, and 20-26 are pending in the application and stand rejected. Claims 2, 4-5, 12-13, and 17-19 were canceled by a Preliminary Amendment filed on December 12, 2005, which appears to have been received and acknowledged by the Examiner prior to the first Office Action. Applicant respectfully requests consideration and favorable action in this case.

Election Restriction

Applicant notes with appreciation the courtesy of the telephone conference with the Examiner on February 24, 2006. While Applicant traverses the restriction requirement, Applicant confirms the restriction election made during that conference to prosecute the invention of Group I (Claims 1, 3, 6-11, 14-16, and 20) and reserves the right to pursue protection for the restricted matter of Group II in at least a Divisional application.

Information Disclosure Statement

Applicant filed an Information Disclosure Statement and PTO Form 1449 on May 7, 2003. The Examiner initialed the patent document listed on the PTO Form 1449, but it appears the Examiner did not initial the non-patent document. Applicant respectfully requests that the Examiner consider the reference and provide the appropriate indication that the cited item was considered.

Section 112 Rejections

The Office Action rejected Claims 1, 3, 6-11, 14-16, and 20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection and all the assertions and holdings therein.

At the outset, in an effort to further prosecution, Applicants have amended independent Claim 15 to recite "logic comprising executable instructions stored on at least one computer-processable medium." This should overcome the traversed rejection involving the "logic stored"

question. Turning to the "processing data" and "processing system" questions, Applicant first notes that the M.P.E.P. does not support the Examiner's present rejection, namely "[i]f the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate." M.P.E.P. §706.03(d). Indeed, M.P.E.P. §2173.02 clearly states that:

> The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:
>
> (A) The content of the particular application disclosure;
> (B) The teachings of the prior art; and
> (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.
>
> In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. ... *See, e.g., Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) ("The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles... Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.").

Applicants respectfully assert that the Examiner has not shown that the present claims are "insolubly ambiguous without a discernible meaning after all reasonable attempts at construction" as required. *See Metabolite Labs.* at 1366; M.P.E.P. §2173.02.[1]

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[1] In the present Office Action, the Examiner requests that the Applicant "explain these limitations in simple terms." Office Action, pg. 4. Applicant respectfully notes these limitations – as read in the light of the specification – are both clear and definite as written. For example, Claim 1 indicates that a sorter retrieves data from checks and records digital images of the checks. Example Claim 1 then includes a processing system that processes each check based on the data retrieved from the check by the sorter in order to generate processing data for the check. At least a portion of this processing data is used to create previous pass information in example Claim 1, which subsequently helps determine whether a check has been previously processed. In other words, the processing data can include certain instructions for processing the check, as well as other data or identifiers of the check being processed, while the previous pass data can include any identifiers and related data for checks already processed (including processing data).

Second, Applicants assert that the present Application provides sufficient and appropriate detail, thereby allowing these claims to particularly point out and distinctly claim the subject matter. For example, the specification indicates that "[t]he system 10 comprises a check sorter 12 for sorting documents, such as checks, for a financial institution or other suitable type of business, *a check processing system 14 for making decisions regarding how the sorter 12 is to process the checks and for notifying the sorter 12 of the decisions*, an image capture host 16 for capturing images of the checks sorted by the sorter 12, an image database 18 external to the sorter 12 for storing images captured by the image capture host 16, and an input/output (I/O) interface 20 for transmitting data between the image capture host 16 and the database 18." *Present Application*, ¶ 13 (emphasis added).[2] In another example, the specification discloses that "[t]he interface 34 interprets and processes data provided by the check processing system 14. Thus, based on the processing data from the check processing system 14, the interface 34 determines for each check whether or not to endorse the check, record a microfilm image of the check and record a digital image of the check." *Id.* at ¶ 19. The specification then provides more example details on the "processing system" and its "processing data" at issue in the Office Action:

> *The check processing system 14 may comprise any suitable combination of one or more of Vector:Sort, Check Processing Control System, SuperMICR, or any other suitable check processing system, and may be implemented on a mainframe.* The check processing system 14 is operable to communicate with the sorter 12 and to make decisions regarding the processing of the check in real time based on the data in the process buffer.[3]
>
> The check processing system 14 comprises previous pass information 40 relating to checks which have been passed through the sorter 12 previously. *The previous pass information 40 may comprise any suitable identifying information as an identifier and other data, such as MICR data or any other suitable data relating to the check, for each of a plurality of checks previously processed by the check processing system 14.* Thus, for example, if a tray of checks being processed by the sorter 12 is dropped or if the sorter 12 jams or if any other situation results in the checks being re-ordered after a portion of the checks have been processed, the previous pass information 40 is able to provide processing

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[2] For ease of reference, the citations to the Present Application refer to the published form of the Application, US 2002/0184151, from www.uspto.gov.

[3] While the claims are not limited to such examples, a person skilled in the art at the time of invention would likely understand the processing – and subsequent processing data – implemented by such example check processing systems.

> data that was previously generated by the check processing system 14 for each of the previously processed checks, thereby eliminating the need to fully process those checks a second time. In addition, a batch of checks that was previously sorted into a same pocket 30 may be sorted again into different pockets 30. In this situation also, the previous pass information 40 improves the efficiency of the check processing system 14.
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> According to one embodiment, the previous pass information 40 is stored in a personal computer or other suitable device operable to store and process data. *The previous pass information 40 may comprise any suitable number of identifiers and related data for previously processed checks.*

Id. at ¶¶20-22 (emphasis added). In yet another example, the present Application indicates that:

> After the check processing system 14 finishes generating processing data for the check, the check processing system 14 updates the process buffer in the memory 32 with *the processing data, which includes instructions for processing the check. According to one embodiment, the processing data indicates whether an image is to be recorded by the microfilm camera 28 and, if so, whether a predetermined number of checks have been recorded by the microfilm camera 28, causing a pause to occur while the microfilm is spaced. The processing data also indicates whether or not a flash is to be enabled for lighting the check as the microfilm camera 28 records a microfilm image of the check. The processing data also indicates whether endorsement data is to be printed on the check by the endorser 26 and which pocket 30 is to receive the check. The processing data also indicates whether any images are to be recorded by the digital camera 22, as well as which images and what types of images.*

Id. at ¶27 (emphasis added). The present Application then indicates how – in some cases – the processing may be used.

> If the processing data indicates that the digital camera 22 is to record an image of the check, the image capture host 16 obtains the digital image data recorded by the digital camera 22. According to one embodiment, the digital camera 22 transmits the digital image data to the image capture host 16 using Transmission Control Protocol/Internet Protocol (TCP/IP). It will be understood, however, that the digital camera 22 may transmit data to the image capture host 16 using other suitable types of communication.
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> The image capture host 16 also obtains the processing data for the check from the check processing system 14 or from the process buffer of the sorter 12. *Based on the processing data, the image capture host 16 determines whether or not the check being processed by the sorter 12 has been processed previously.*
>
> If the check has been processed previously, *the image capture host 16 matches an identifier for the check in the processing data to an identifier in the previous pass information 40.* The image capture host 16 then obtains at least a portion of the data corresponding to the check from the previous pass information

> 40 in the check processing system 14. This data is used instead of the corresponding processing data that was previously obtained in order to provide consistency. For example, the image capture host 16 may obtain an original date and an original sequence number for the check in order to uniquely identify a check whose date and/or sequence number may have been modified from one pass to another. If the check has not been processed previously, the image capture host 16 simply utilizes the processing data obtained from the check processing system 14 or from the process buffer of the sorter 12.

Id. at ¶31-33 (emphasis added). Based on these citations alone, "the scope of the claimed subject matter can be determined by one having ordinary skill in the art." Of course, these citations are for example purposes only and merely represent a sample of – and not required or imported embodiments of – the present Application. Simply, for at least these reasons, Applicant respectfully asserts that the present Application provides sufficient and appropriate detail, thereby allowing these claims to particularly point out and distinctly claim the subject matter, and requests reconsideration and withdrawal of the 35 U.S.C. § 112 rejection.

The Claims are Allowable Over *Cahill*

The Office Action rejected Claims 1, 3, 6-11, 14-16, and 20 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,678,046 to Cahill et al. ("*Cahill*"). Applicant respectfully traverses these rejections and the assertions and holdings therein because *Cahill* fails to teach, suggest, or disclose various aspects of the present claims as required by law.[4]

For example, *Cahill* simply fails to teach – and instead teaches against – an image capture host that, in the event of restarting processing for at least a subset of the plurality of checks, obtains "the processing data generated for each check by the processing system" and automatically determines "whether processing data was previously generated for a specified check and, if processing data was previously generated for the specified check, to obtain at least a portion of the previous pass information for the specified check from the database via the processing system such that the specified check is not substantively reprocessed" as recited in

[4] A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

example Claim 1. In some cases, by "eliminating the need to fully process those checks a second time," this previous pass information may "improve[] the efficiency of the check processing system 14." *Present Application*, ¶ 21.

In direct contrast, *Cahill* discloses that during a subsequent pass *the original image and associated data is discarded* and the check is fully reprocessed. Generally, *Cahill*'s system decodes a MICR line, then passes the check to "one of the eight output pockets, i.e. the repair pocket 208, the repass pocket 209 or one of the six normal sort pockets 210. Checks 1 that are routed to the repass pocket 209 are again placed in the input hopper during the repass run of the sorter 200. During the repass run, checks 1 are manually placed in the input hopper 203 as shown by dashed lines 207, processed to the repair pocket 208 (described in greater detail below), one of the six normal pockets 210 or killed (removed from processing)." *Id.* at 14:26-36.[5] But *Cahill* then notes that the repass check is placed in the input hopper and *the original image and associated data is discarded*.

Particularly, FIGUREs 5A-B confirm that *Cahill*'s repass processing is identical to normal processing except that it allows the operator to manually decide to accept or reject the repassed check. For example, *Cahill* discloses that if no errors or inconsistencies are found in a check's normal processing, then "the sorter 200 is controlled to send check 1 to one of the normal pockets 210 (see 251), the image and associated data are converted to a TIFF file (252) and the merged TIFF file 22 is written to the storage space 505. (See 253)... *Checks 1 with an equal or a greater number of inconsistencies than a threshold number are sent to a repass pocket 209 (see 263) and the associated image is discarded.*" *Id.* at 19:20-33 (emphasis added). Then, after all normal processing is complete in *Cahill*, "the operator may switch to the repass mode (FIG. 5B). The objective of the repass mode is to have an operator review each check 1 having a number of inconsistencies at or above the threshold level, individually." *Id.* at 19:40-43. To be clear, *Cahill* expressly recites that the "repass mode differs from normal processing *only in the way checks are handled if a threshold number or more errors are present.*" *Id.* at 19:50-52 (emphasis added). During repass processing, *Cahill* teaches that the "operator can also decide to

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[5] In another example, *Cahill* teaches that "[w]hen inconsistencies exist between the optically and magnetically decoded MICR lines or, where one or more characters were not decoded by either the MICR reader 205 or the OCR device 206, the check 1 can either be directed to the repass pocket 209 for re-processing on the sorter 200 or to the repair pocket 208 for MICR line correction at the repair station 4 (FIG. 1)." *Cahill*, 18:63-19:2.

reprocess the check 1 on the sorter 200 (see 275), at which time the operator removes the check 1 from the track 220 and places it in the input hopper 203 (see 276). *The image and data associated with that check 1 are then discarded (see 264).*" *Id.* at 19:60-42 (emphasis added). In short, there is no teaching or suggestion in *Cahill* that any previous pass information is returned from a database external to the sorter or otherwise used in any way during subsequent passes. In fact, *Cahill* teaches that in the event of repass in *Cahill*'s system, the check's image and associated data are expressly discarded.[6]

For at least these reasons, Applicant submits that *Cahill* fails to teach, suggest, or disclose – indeed often seems to teach against – certain aspects of the present claims. Accordingly, Applicant requests reconsideration and allowance of Claims 1, 3, 6-11, 14-16, and 20.

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[6] The Office Action cites *inter alia* columns 32 and 20 of *Cahill* for alleged teaching of previously generated processing data and its use by the image capture host. Not only does column 32 not teach what the Office Action asserts, but column 32 is directed towards a customer workstation 7, which does not appear to be comparable to the "image capture host" of example Claim 1. Similarly, column 20 fails to teach what the Office Action asserts and is instead directed towards a repair station 4, which does not appear to be comparable to the "image capture host" of example Claim 1. Put simply, neither of these or other cites (whether individually or combined) teach, suggest, or disclose "in the event of restarting processing for at least a subset of the plurality of checks, the image capture host is further operable to ... obtain the processing data generated for each check previously processed by the processing system [and] automatically determine whether processing data was previously generated for a specified check and, if processing data was previously generated for the specified check, to obtain at least a portion of the previous pass information for the specified check from the database via the processing system such that the specified check is not substantively reprocessed" as recited in example Claim 1.

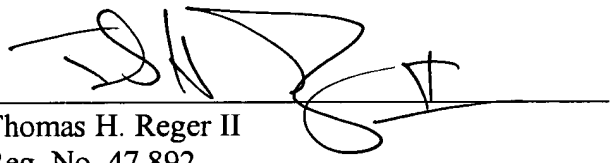
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all Claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, **Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference**.

Applicant believes no fees to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to deposit account 06-1050.

Respectfully submitted,



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